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Appeal No. 652-51

PSB

ON BRIEF

AUG 28 1987
PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCESEx parte Ole K. Nilssen

Application for Patent filed October 13, 1983,
Serial No. 541,489. This application is a Continuation of
Serial No. 342,107, filed January 25, 1982, abandoned.
Electronic Ballast for Fluorescent Lamps.

Ole K. Nilssen pro se.

Primary Examiner - Leo H. Boudreau.
Examiner - V. DeLuca.

Before Spencer, Craig and Lynch, Examiners-in-Chief.

Spencer, Examiner-in-Chief.

This appeal is from the final rejection of claims 48 through 51. The examiner states that claim 45, the only other claim remaining in the application, is allowable.

The references relied on are:

Agnew	4,008,414	Feb. 15, 1977
Nilssen	4,184,128	Jan. 15, 1980

Claims 48 through 51 stand rejected under 35 U.S.C. 103 as unpatentable over Nilssen in view of Agnew. Reference is made to the answer for the position of the examiner and to the principal and reply briefs for the position of appellant.

OPINION

We have reviewed the entire record and given careful consideration to the positions of appellant and the examiner. We conclude that the examiner is correct in holding that the claims at bar would have been obvious within the meaning of section 103 in view of the cited prior art. For the reasons given by the examiner for the rejection and our additional comments infra, we sustain the rejection.

The examiner's position is that a person having ordinary skill in the art would have been motivated to modify Nilssen in view of Agnew in order to avoid useless power dissipation by the production of trigger pulses when no load is connected to the output.

Appellant argues that such a motivation is meaningless since the power dissipation associated with the triggering function in a typical triggered inverter is only about five milliwatts as compared to an inverter output of 100 watts. Appellant urges that such an insignificant power dissipation would not have provided any motivation to one of ordinary skill in the art to make the proposed modification.

Appellant's argument is not persuasive. Appellant also argues that, in the prior art, RFI is significantly detrimental during frequently occurring long periods when the inverter is supplied with DC voltage with no load connected. Appellant further argues that there are anticipated usage situations in which the rectifier/inverter will be connected to the power line for extended periods of time but a load will only be connected during occasional brief periods of time. Thus, continued application of needless trigger pulses is like a leaky faucet. One drop of water is rather minuscule but the constant drip-drip-drip of a leaky faucet can result in more water consumption from leakage

than from intentional, infrequent turning on of the faucet. The wasted power resulting from needless trigger pulses can indeed be significant.

Appellant presents a strange argument. He states:

Thus, the invention as expressed by the generic claim, or by claim 48, may be considered as a modification of Nilssen's Fig. 8: a modification by which resistor 213 is moved to connect with the point marked 210 (or some point that is DC-equivalent thereto), and where transformer 207 -- which represents the load on the inverter -- is removable.

In figure 8 of Nilsson, resistor 213 is connected to a DC equivalent of point 210. Resistor 213 is connected to point 210 through the primary of transformer 207 (a DC short) and coils 208 and 209 (DC shorts). Transformer 207, like any element in any circuit, is removable. Thus, appellant, in fact, argues that appealed claim 48 reads on figure 8 of Nilsson.

Appellant asserts that his invention resulted in the elimination of the problem of radio frequency interference resulting from continuous application of trigger pulses with no load connected. Appellant cites In re Roberts, 470 F.2d 1399, 176 USPQ 313 (CCPA 1973), for the proposition

"Where unobvious aspect of invention resides in recognition of source of problem, Patent Office inquires should be directed, in part at least, to question of whether such a recognition would have been obvious to one of ordinary skill in the art; inquiry must go beyond the nature of the solution"*

*Appellant's quotation is from the USPQ headnote. While a headnote is authority for nothing, we note that the court, in Roberts, said (citation omitted) "[t]he unobvious aspect of this invention resides in the recognition of the source of the problem Therefore, the inquiries in the Patent Office should have been directed, at least in part, to the question of whether or not such a recognition would have been obvious to one of ordinary skill in the art."

and In re Sponnoble, 405 F.2d 578, 160 USPQ 237 (CCPA 1969),
for the proposition

"patentable invention may lie in
discovery of source of problem
even though remedy may be obvious
once source of problem is identi-
fied."

The present application is a continuation of applica-
tion S.N. 342,107 filed January 25, 1982. The problem of RFI
is first mentioned in paper number 11** filed December 24, 1984.
No mention is made of the problem in the specification. Clearly,
then, recognition of the RFI problem played no part in appellant's
invention of the claimed subject matter. In accordance with
35 U.S.C. 103, the issue of obviousness is determined as of
the time the invention was made (the filing date of the parent
application in the present case). Subsequent recognition of
the RFI problem has no bearing on the issue of obviousness
as of the time the claimed invention was made. At the time
the present invention was made, one of ordinary skill in the
art would have been motivated to combine Nilssen and Agnew
in the manner proposed by the examiner to avoid the very
real and readily recognized unnecessary waste of power.

Appellant's arguments directed to the alleged failure
of the examiner to comply with MPEP 706.02 are not relevant
to the issues before us. Our decision is based on the merits
of the rejection, not the procedural aspects of prosecution
before the examiner. Appellant had recourse to the Commissioner
by way of petition if he was dissatisfied with the examiner's
failure to comply with the MPEP. It is not an issue which can
be raised on appeal.

**Identified as Amendment B by appellant but entered as
Amendment C.

Appellant's arguments directed to the Zansky patent are not germane. There is no rejection based on the Zansky patent before us. What patentee Zansky did or did not know with respect to the prior art and what he did or did not do is irrelevant to the issue before us. The issue of obviousness is determined entirely with respect to the hypothetical person having ordinary skill in the art. Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 227 USPQ 293 (Fed. Cir. 1985). As the court, in Standard Oil, said (emphasis in the original) "one should not go about determining obviousness under §103 by inquiring into what patentees (i.e., inventors) would have known or would likely have done, faced with the revelation of references."

DECISION

The rejection of claims 48 through 51 under 35 U.S.C. 103 and the decision of the examiner are affirmed.

AFFIRMED

Richard A. Spencer, Jr.)
Examiner-in-Chief)
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Jerry D. Craig)
Examiner-in-Chief)
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Thomas E. Lynch)
Examiner-in-Chief)
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